

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GANESH S. GANESAN,
MICHAEL A. HELSER
MYRON M. UECKER
and TODD W. GUSEK

Appeal No. 1997-0164
Application 08/349,300

ON BRIEF

Before OWENS, WALTZ and JEFFREY SMITH, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 9, 11 through 15, and 22 through 29 as amended subsequent to the final rejection (see the amendment dated Mar. 7, 1996, Paper No. 9, entered as per the Advisory Action dated Mar. 19, 1996, Paper No. 10).

These are the only claims remaining in this application.

Claims 5 through 9, 11 and 25 were indicated as objected to by the examiner as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (Answer, page 7). Accordingly, claims 1 through 4, 12 through 15, 22 through 24 and 26 through 29 remain under appeal.

According to appellants, the invention is directed to a method of forming popcorn bars where unpopped and partial kernels are removed from popped popcorn, a molten binder in the form of a caramel syrup is coated on the popped popcorn, this mixture is compressed into a sheet, cooled, and cut into bars (Brief, pages 1-2). Illustrative claims 1 and 22 are reproduced and attached as an Appendix to this decision.

The examiner has relied upon the following references as evidence of obviousness:

Dodge ¹	2,181,109	Nov. 21, 1939
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¹ The examiner has failed to list this reference under "Prior Art of record" on page 3 of the Answer but has included this reference in the statement of the rejection on page 4 of the Answer. Since this reference was included in the Final

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Bell	3,009,427	Nov. 21, 1961
Tay	3,958,018	May 18, 1976

Rejection (Paper No. 8, page 2) and discussed in the Brief (pages 3 and 5), we hold this omission in the Answer to be harmless error.

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Knechtel	4,098,914	Jul. 4, 1978
Simelunas	4,719,117	Jan. 12, 1988
Ban et al. (Ban)	5,106,636	Apr. 21, 1992

The claims on appeal stand rejected under 35 U.S.C. § 103 as unpatentable over Bell or Knechtel, Ban, Dodge, Simelunas and Tay (Answer, page 4).² We reverse this rejection for reasons which follow.

OPINION

The examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent

²The examiner apparently includes a separate rejection of claims 12 and 13 under § 103 over "the combined art above as applied ... further in view of Simelunas." (Answer, page 7). However, Simelunas was already applied in the first ground of rejection (Answer, page 4). Since this rejection stated on page 7 of the Answer was not in the Final Rejection (see Paper No. 8), we consider this rejection to be part of and an elaboration of the rejection restated on page 4 of the Answer. Furthermore, we note that the examiner has not considered claims 26 through 28 in the Answer. For purposes of this appeal, we consider claims 26 through 28 with the rejected claims as per the Final Rejection (see Paper No. 8). The omission of these claims from the Answer is harmless error in view of our decision *infra*.

some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997). As stated by our reviewing court in *In re Dembiczak*:³

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, [citations omitted], although 'the suggestion more often comes from the teachings of the pertinent references' [citation omitted]. The range of sources available, however, does not diminish the requirement for actual evidence. That is, *the showing must be clear and particular.* (Emphasis added).

The examiner finds that Bell discloses a process of making a confection of peanuts by coating the peanuts with syrup, plasticizing the nuts, compressing the mixture to a uniform thickness, conveying the product on a belt, and cooling the product (Answer, page 4). The examiner also finds that Knechtel discloses comminuting popcorn to add to a peanut brittle mixture, using a conveyor, binder and a cooling device (*id.*). The examiner recognizes the differences between the claimed subject matter and the primary references to Bell and

³ 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Knechtel (*id.*). Accordingly, the examiner applies Dodge, Ban, Simelunas and Tay to show other limitations of the claimed subject matter (Answer, pages 4-5). However, the examiner's conclusion of obviousness is not based on any evidence of why it would have been obvious to combine the teachings of the applied references, even assuming the individual references taught each and every limitation of the claims (Answer, page 5; see the Brief, page 8).

Bell is directed to peanut brittle only while Knechtel is drawn to a peanut brittle product with a small amount of comminuted popcorn added (see Bell, col. 1, ll. 9-10; Knechtel, col. 2, ll. 33-39). The examiner has not established any convincing evidence or reasoning as to why one of ordinary skill in the peanut brittle art would have used the rollers of Ban to compress the peanut brittle mixture of Bell or Knechtel, especially considering that Ban is directed to "dough or other similar viscoelastic materials." (col. 1, ll. 7-8). Similarly, the examiner has not established any motivation or suggestion to support the proposed combination of Bell or Knechtel with Tay, who discloses an apparatus with

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transversely mounted blades for cutting a ribbon material into distinct pieces (Answer, page 5). It is noted that Bell teaches that his peanut brittle may be scored and broken into any desired shape while Knechtel teaches fracturing the ribbon so that it is broken into individual pieces of peanut brittle by use of a roller 55 having a plurality of

projecting spikes **56** (see Bell, col. 4, ll. 3-10; Knechtel, col. 5, ll. 28-41).

Dodge is directed to a popcorn coated with a thin candy syrup (col. 2, ll. 4-8). The examiner has not established what suggestion would have led the ordinary artisan to combine this reference with the peanut brittle mixtures of Bell or Knechtel. It is noted that the examiner appears to apply this reference alone against claim 22 on appeal, which is in product-by-process form (Answer, page 6). However, the reference to Dodge, although exemplifying a popcorn bar (see Figure 5), does not disclose or teach the limitations recited in claim 22 that the popcorn has been compressed, that the binder is a caramel syrup, or that a confectionary coating has been drizzled on the top of the bar (see Dodge, col. 2, ll. 9-13 and 24-28). Thus the examiner has failed to establish that the prior art reasonably appears to disclose a product which is identical to or only slightly different than the claimed product.

In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

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Simelunas is directed to co-extrusion of two dissimilar materials such as dough pieces (col. 1, ll. 10-27; col. 2, ll. 46-54). The examiner has not set forth any suggestion as to why one of ordinary skill in the art would have been led to combine

the teachings of this reference with the primary references to peanut brittle as taught by Bell and Knechtel.

General statements regarding the motivation or suggestion are not sufficient, such as the examiner's general statements regarding the "confection art" (Answer, page 8), "well known" process steps (Answer, pages 9 and 11), and the use of apparatus for "their known functions" (Answer, page 10). The showing of evidence regarding the motivation or suggestion to combine the references as proposed by the examiner "must be clear and particular." *Dembiczak, supra*.

For the foregoing reasons, we determine that the examiner has failed to establish a *prima facie* case of obviousness in view of the reference evidence. Accordingly, the rejection of the claims on appeal under 35 U.S.C. § 103 is reversed.

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The decision of the examiner is reversed.

REVERSED

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY SMITH)	
Administrative Patent Judge)	

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Appendix

1. Method for forming popcorn bars having a width and a length comprising the steps of: providing popped popcorn; providing a molten binder; removing any unpopped and any partial kernels from the popped popcorn; coating the popped popcorn with the molten binder after removal of any unpopped and partial kernels; compressing a mass of the coated popped popcorn into a compressed sheet; reducing the temperature of the coated popped popcorn to a temperature to solidify the binder and to bind the popped popcorn; cutting the compressed sheet with knives into a plurality of strips having a width equal to the width of the popcorn bars; and cutting the plurality of strips with at least one knife to a length equal to the length of the popcorn bars.

22. Popcorn bar having a top, a bottom, first and second ends, and first and second sides comprising, in combination: popped popcorn; a binder for binding the popped popcorn in the form of a caramel syrup formed by heating a mixture of water, sugar, corn syrup, molasses, salt, oil and lecithin to a temperature in the order of 82°C and then cooking the mixture at a temperature in the order of 149°C, with the top and bottom being defined by a mass of the popped popcorn coated with the binder in a molten form compressed into a sheet, with the ends and sides being formed by cutting the sheet with knives, with the coated popped popcorn between the ends and sides being substantially free of unpopped and partial kernels; and confectionery coating drizzled in a zig-zag pattern on the top.